

### **REMARKS/ARGUMENTS**

The Office Action mailed November 17, 2006, has been carefully reviewed and this paper is Applicant's response thereto. Claims 1-33 are pending. Claims 1, 15, 20, 29 and 30 are amended. Claims 1-2, 4-5, 8-15, 20-22 and 29-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,250,720 to Entrop *et al.* (Entrop). Claims 23-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Entrop in view of U.S. Patent No. 5,743,627 to Casteel (Casteel). Claims 3, 6-7, 10, 16 and 18-19 were rejected under 35 U.S.C. §102(a) as being unpatentable over Entrop in view of U.S. Patent No. 4,516,197 to Yonkers *et al.* (Yonkers).

#### **Allowable Subject Matter**

Applicant appreciates the notification of allowable subject matter. Claim 15 has been rewritten in independent form and is believed to be in condition for allowance. Applicant also notes that claims 17 and 18 have not been rejected and thus are directed to allowable subject matter. Accordingly, notification that claims 17 and 18 are allowable is respectfully requested.

Additional subject matter is believed allowable and is addressed below.

#### **Amendments to the Claims**

Applicant appreciates the notification of informalities in the claims and has amended claims 1 and 20 to correct the noted informalities.

In addition, claim 1 has been amended to clarify the intended scope and now recites, in relevant part, "wherein the plurality of light blocking areas on the first side gradually decreasingly block light along the first path and the plurality of light blockings areas on the second side gradually decreasingly block light along the second path."

Claim 29 has also been amended to claim more appropriate scope. Thus, an aspect of claim 29 has been broadened to omit recitation of the three coverage areas while the coverage area is now recited as incrementally decreasing.

Claim 30 has been amended to clarify the intended scope of the claim.

#### **Rejection under 35 U.S.C. § 102(b) - Entrop**

Claims 1-2, 4-5, 8-15, 20-22 and 29-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Entrop. Claims 1, 20 and 29 are independent.

Regarding independent claim 1, it now recites the feature “wherein the plurality of light blocking areas on the first side gradually decreasingly block light along the first path....” The Office Action appears to admit that Entrop fails to disclose this feature, thus Entrop cannot be said to anticipate claim 1. Accordingly, claim 1 is believed to be in allowable condition.

Claims 2, 4-5, and 8-14 depend from claim 1 and are not anticipated for at least the above reasons and the additional features recited therein.

Regarding independent claim 20, as previously noted, Entrop completely fails to disclose the feature of “a light shield mounted to the fixture ... wherein a percentage of light from the light source can pass through the light shield at the center” as recited in claim 20. The Office Action, while maintaining the rejection of claim 20, no longer makes any arguments that support the rejection of claim 20 and has failed to suggest the above feature is disclosed by Entrop. Accordingly, it is understood that the previous grounds for rejection have been withdrawn. Indeed, claim 20 is believed allowable for reason similar to why claim 15 was deemed allowable. Therefore, as Entrop fails to disclose all the features of claim 20, Entrop cannot be said to anticipate claim 20. Consequentially, claim 20 is allowable over the references of record.

Claims 21-22 depend from claim 20 and are allowable for the reasons that claim 20 is allowable and for the additional features recited therein.

Regarding independent claim 29, the feature “using a light shield including a center and an outer edge to decreasingly shield a percentage of the light source along a path from the center to the outer edge, wherein the coverage area of the shield incrementally decreases from the center to the outer edge” is recited. As the Office Action appears to admit that Entrop fails to disclose such a change in what is being read as the light shield, claim 29 is believed to be in allowable condition.

Claims 30-33 depend from claim 29 and are not anticipated for at least the reasons discussed above and for the additional features recited therein. For example, claim 32 recites that the maximum light quantity is 50 degrees from perpendicular and Entrop merely discloses a maximum at less than 20 degrees from perpendicular, which is well short of the recited feature.

#### **Rejection under 35 U.S.C. § 103(a) – Entrop and Casteel**

Claims 23-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Entrop in view of Casteel. The Final Office Action has admitted that Entrop does not disclose the

claimed feature of a maximum thickness of 1.5 inches but suggests that Casteel teaches this and it would have been obvious to modify Entrop in view of Casteel to reach the recited feature. However, as previously noted, this is incorrect because Casteel only discloses a minimum thickness of 1.7 inches and thus fails to disclose the recited feature of a maximum thickness of 1.5 inches. In addition, the cited section of Casteel suggests that 1.7 inches is extremely thin, thus negating any suggestion that there is any teaching for an even thinner fixture based on the Casteel reference:

**The fixture 10 is also of extremely narrow or low profile  
and generally will have a height or thickness of only one and  
7/16" and a width of only 7". The length of the fixture 10 is 15**

Castell, Col. 3, Ln. 13-15.

In addition, as previously noted, Entrop and Casteel function in completely different ways and there is no teaching or suggestion in either reference (or anywhere else) that explains how one would modify Entrop so that it would work with a maximum thickness of 1.5 inches. In this regard, it is Applicant's position that a long-felt need exists for a thin fixture but it is impossible to modify Entrop to obtain such a fixture. This is because Entrop works by directing light from a light source to a prismatic reflector 7 which then directs light to a concave reflector 1. While not limited to the scale shown, the design illustrated in Entrop is at least 3 and 1/2 inches – there is nothing to suggest this thickness could be reduced to less than 2 inches, let alone less than 1.5 inches as claimed. This is because the angle of the prismatic reflector 7 and the concave reflector 1 would become too flat to provide the desired light shaping as recited in claim 23 (or shown in Figure 3 of Entrop).

The inability for a person of skill in the art to modify Entrop to obtain a fixture that is less than 1.5 inches thick was previously noted. However, the Office Action has completely failed to address this point and has merely provide conclusory remarks about how the two references could be combined without any persuasive reasoning for why this is so. This type of conclusory rejection is improper because, as the Supreme Court recently explained, "[t]o facilitate review, this analysis should be made explicit." *KSR Int'l Co. v. Teleflex Inc.*, -- U.S. ---, 82 U.S.P.Q.2d 1385, 2007 WL 1237837, \*13 (2007). (citing to *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead,

there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). Here, there are no rational underpinnings because the design of Entrop would cease to function as intended (and plainly would not meet the limitations of claim 23) if it was made less than 1.5 inches thick. Thus, the Office Action fails to provide any support for how a person of skill in the art would modify Entrop based on the teaching of Casteel.

Applicants further note that *In re Aller*, 105 USPQ 233, is not applicable here. This is not a situation where the general conditions have been disclosed because prior to Applicant’s disclosure there was no way to provide a fixture that was less than 1.5 inches thick that could provide the recited features of claim 23. In other words, the range of fixture thicknesses that could provide the features recited in claim 23 did not extend to less than 1.5 inches before Applicant’s disclosure. At most, the Office Action has provided support that a light fixture existed that could not provide the recited features of claim 23 and could get close to, but could not meet, the recited less than 1.5 inches feature of claim 23. This is insufficient to support a proper obviousness rejection.

Accordingly, for at least the above reasons the rejection of claim 23 lacks proper support and the combination of Entrop and Casteel, even if these references could be properly combined, fails to disclose, suggest or teach all the features of claim 23. Therefore, claim 23 is nonobvious in view of Entrop and Casteel.

Claims 24-28 depend from claim 23 and are nonobvious in view of the cited reference for at least the above reasons and for the additional features recited therein.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

#### **Rejection under 35 U.S.C. § 103(a) – Entrop & Yonkers**

Claims 3, 6-7, 10, 16, and 18-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Entrop in view of Yonkers. These claims, however, depend from independent claim 1, and, as discussed above, Entrop fails to disclose, suggest or teach all the limitations of claim 1. The Office Action has not suggested that Yonkers corrects the above noted deficiencies in Entrop, nor does Yonkers appear to be able to do so. Accordingly, the combination of Entrop and Yonkers fails to support a *prima facie* case of obviousness with respect to claim 1.

In addition, Applicants note that Entrop and Yonkers operate in substantially different ways and it does not seem possible to modify Entrop with the teachings of Yonkers. In other

words, the Final Office Action has provided no support for how the reflectors 1, 6 and 7 could be modified so as to work when shaped to provide the features recited in dependent claims. Rather, as previously noted, such a modification would prevent Entrop from providing the desired functionality. In other words, the two references are incompatible. For example, the reflector 6 currently runs from the reflector 7 to the reflector 1 in a manner that is parallel to the light that passes from the reflector 7 to the reflector 1 (light from the reflector 1 is then directed to the floor). If the reflector 6 were modified to provide a truncated diamond shape then the reflector 6 would block the light intended to pass from the reflector 7 to the reflector 1 and Entrop would cease to function properly. Therefore, if the rejection is maintained, Applicant respectfully requests a more detailed explanation of how Entrop would work once modified by Yonkers to include the features recited in the dependent claims because it currently appears to be impossible to make such combinations.

Accordingly, for at least the above reasons, withdrawal of this ground of rejection is respectfully requested.

### **CONCLUSION**

As all rejections have been addressed, Applicant respectfully requests reconsideration of the application and allowance of all pending claims.

Respectfully submitted,

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